

REMARKS

This Amendment responds to the Office Action dated August 23, 2006.

The Examiner rejected claims 1-40, 50-53, and 55-59 under 35 U.S.C. § 103(a) as being obvious in view of the combination of IT-JPEG 200 and Qian et al., U.S. Patent No. 6,070,167 (hereinafter Qian). The applicant has already submitted a declaration from the inventor, establishing an invention date prior to the publication of Qian. The Examiner, however, contends that the effective date of Qian under 35 U.S.C. § 102(e) is earlier than the publication date of the reference. Qian is unavailable as a reference in a rejection under 35 U.S.C. § 103(a), because, in view of the previously-submitted declaration, Qian is eligible as prior art only under 35 U.S.C. § 102(e) and, **at the time the present invention was made, Qian and the subject matter of the claimed invention were commonly owned by Sharp Laboratories of America, Inc., the assignee of both the present invention and Qian.** Therefore, Qian is removed from consideration as prior art. *See* 35 U.S.C. § 103(c); *See also* MPEP 706.02(1). The applicant therefore respectfully requests that the rejection of claims 1-40, 50-53, and 55-59 under 35 U.S.C. § 103(a) be withdrawn.

The Examiner rejected claims 1-59 under 35 U.S.C. § 101, arguing that the claims, being directed to a digital file, were directed to non-statutory subject matter. The Examiner's rejection is contrary to both the MPEP and case authority that is directly on point. *See In re Wammerdam*, 31 USPQ2d1754, 1759 (Fed. Cir. 1994); *see also* MPEP § 2106. In *Wammerdam*, the Federal Circuit first evaluated method claims 1-4 and 6, each directed to a method for "creating a bubble hierarchy," which the federal circuit viewed as a mathematical construct. The court held that such claims were not directed to statutory subject matter because they claimed *nothing more* than

the *abstract* manipulation of data, i.e. a person mentally creating the bubble hierarchy in the claimed manner, or doing so on paper, would infringe the claims. The court went on, however, to evaluate claim 5, which was directed to a computer having *a memory that stored data* arranged in the same “bubble hierarchy” that was claimed in the unpatentable claims 1-4 and 6. The court stated that claim 5 was “clearly patentable subject matter” because it was directed to a *thing* rather than an abstraction. Thus, the claims of the present application, being each directed to a digital file “stored on a computer readable medium” claims patentable subject matter because it is directed to an object, rather than *merely* an abstract arrangement of data.

The MPEP dictates the same result. *Compare* MPEP at § 2106, 2100-11(“Abstract ideas or the *mere* manipulation of abstract ideas are not patentable)(emphasis added)(citations omitted) and *Id.* at § 2106, 2100-13 (“*In contrast, a computer-readable medium encoded with a data structure* defines structural and functional relationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and *is thus statutory.*”)(emphasis added).

The Examiner cites inapposite portions of the MPEP, which deal with claims, *themselves directed* to literary or musical works, to support the non-statutory subject matter rejection. These portions of the MPEP only apply to claims directed to descriptive material that “*cannot* exhibit *any* functional interrelationship with the way in which computing processes are performed.” MPEP at § 2106, 2100-13(emphasis added). For example, a claim that reads “a computer disk containing Dostoyevsky’s ‘Crime and Punishment’” does not become patentable subject matter merely because the literary work is stored on a computer-readable medium. However, a claim directed generically to either a “method for storing literary works on a computer-readable

medium” and specifying a novel data format in which literary works could be stored, or a computer-readable medium storing a literary work in a novel data format, are each patentable because the claimed data format, by definition, exhibits “structural and functional relationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized.” MPEP at § 2106, 2100-13.

The Examiner’s assertion that claims 1-59 are directed to nonfunctional descriptive material is incorrect, contradicting the portions of the MPEP cited above, which indicate that claims directed to specified data structures stored on a computer-readable medium are, *per se*, functional. Moreover, each of the rejected claims specifically indicates the functional relationships between the claimed data structures. For example, independent claim 1 includes the limitations of “a plurality of boxes containing data . . . suitable to render an image when read by a computer” and “including information within said metadata box *describing the content of said image*”, thereby describing the functional relationship between the metadata box and the “plurality of boxes. . . containing data suitable to render an image.” Similarly, each of the other rejected claims contain limitations specifying functional relationships between claimed elements.

For each of the foregoing reasons, the applicant respectfully requests that the Examiner withdraw the non-statutory double patenting rejection of claims 1-59.

The Examiner rejected claims 41, 42, and 46 under 35 U.S.C. § 102(b) as being anticipated by Pereira. Independent claim 41, as amended, recites the limitation of previously-dependent claim 43, which has been canceled. Claim 43 was only rejected under 35 U.S.C. § 101, a rejection that has been traversed for the reasons previously stated. Therefore, the applicant

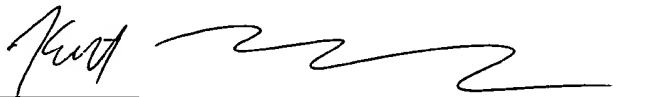
Appl. No. 09/882,416
Amdt. dated November 22, 2006
Reply to Office Action of August 23, 2006

respectfully requests that the Examiner withdraw the rejection of claims 41, 42, and 46 under 35 U.S.C. § 102(b)..

The Examiner rejected claims 47-49 and 54 under 35 U.S.C. § 102(a) as being anticipated by IT-JPEG 2000. To support this rejection, the Examiner argues that the cited reference discloses UUID info boxes that each index UUID boxes, and that may include links to information outside the UUID box. The Examiner reasons that the claimed metadata box could read on the claimed UUID info box. As amended, independent claim 47, from which claims 48, 49, and 54 respectively depend, recites the limitation of "including information within said UUID box indicating the location of binary data, within said file and not within said UUID box, associated with said image." This limitation is not disclosed by any of the cited references. Therefore, the applicant respectfully requests that the rejection of claims 47-49 and 54 be withdrawn.

In view of the foregoing amendments and remarks, the applicant respectfully requests reconsideration and allowance of claims 1-42 and 44-59.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Kurt', followed by a long, wavy horizontal line that extends across the width of the signature area.

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